

JUL 23 2007

REMARKS

Applicant has carefully considered the Examiner's Office Action and has amended the claims to define the invention in clearer form and to distinguish patentably from the prior art.

For this purpose, applicant has replaced claim 1-23 with the newly submitted claims 24-45. These new claims 24-45 avoid the objections raised by the Examiner on page 2 of the Office Action.

Accordingly, the new claims 24-45 are drafted to provide for the necessary antecedents and the corrections required by the Examiner.

Applicant has also drafted the new claims to include the subject matter and limitations whereby the new claims do not read on the prior art.

To aid the Examiner in considering applicant's invention in relation to the prior art, applicant is reproducing below claim 24 with reference numerals inserted.

24. (new) An arrangement for variable actuation of gas exchange valves of internal combustion engines comprising:

at least one cam 2 on a camshaft 1 mounted in said housing and rotating dependent on engine speed;

an intermediate link 4 driven by said cam 2;

a bolt 6 having an axis 7 and mounting said intermediate link, said intermediate link carrying out an oscillating purely rotational motion about said axis, said bolt 6 being displaceable parallel to itself along an adjustment curve 28;

a control curve 5 on said intermediate link 4 and having a rest region 5a as well as a lift region 5b;

a driving element 11 actuated by said control curve for actuating in turn at least one of said valves 13;

a four-bar linkage 24-27 connected with an engine cylinder head for guiding said bolt and having first joints 24, 26 and second joints 25, 27, said first joints 24, 26 comprising two

joints fixed and spaced from each other in a first spacing, said second joints 25, 27 comprising two second joints each pivotable about one of said first joints 24, 26, said two second joints 25, 27 having a spacing between them smaller than the spacing between said two first joints for guiding said bolt 6 on a substantially arc-shaped adjustment curve 28.

The Examiner has applied the reference patent 6,792,903 in rejecting the claims. This patent, however, differs from applicant's invention by relating to a mechanically controllable valve lift adjustment in internal combustion engines.

The Examiner has also applied reference Patent 6,481,399 in the rejecting of the claims. This patent relates to a mechanically regulated valve stroke adjuster in which a lifting lever is mounted rotatably and slidably in a guide block. A camshaft drives the lifting lever and a working curve. A valve interacts with the working curve of the lifting lever and is moved by it.

However, neither of these references applied by the Examiner, disclose a four-bar linkage 24-27 connected with an engine cylinder head for guiding the bolt and having first joints 24, 26 and second joints 25, 27. The first joints 24, 26 are two joints fixed and spaced from each other in a first spacing. The second joints 25, 27, also not shown in the prior art, have two joints each pivotable about one of the first joints 24, 26. The two second joints 25, 27 have a spacing between them which is smaller than the spacing between the two first joints for guiding the bolt 6, unlike what is disclosed in the prior art. The bolt 6 is guided on a substantially arc-shaped adjustment curve 28 which is also not present in the prior art.

Accordingly, applicant's new claims 24 and the dependent claims thereon do not read on the prior art. Instead, applicant provides for a new and marked improvement over the prior art. Since the claims in the application differ materially from the

prior art, it is believed that the new claims should be found allowable.

The Examiner's attention is respectfully directed to the decision of the District Court in the case of United Merchants and Manufacturers Incorporated versus Ladd (139 U.S.P.Q. 199), in which the Court ruled that although from simplicity of device and with advantage of hindsight, one might offhandedly be of opinion that anyone should have been able to make invention after studying prior art, claims are allowed since none of the reference discloses or suggests the concept which is the crux of the invention.

Furthermore, in the case of Ex parte Fleischmann (157 U.S.P.Q. 155), the Patent Office Board of Appeals ruled that while it might be possible to select features from secondary references and mechanically combine them with primary reference to arrive at applicant's claim combination, there is no basis for making such combination disclosed or suggested in references; only applicant's specification suggests any reasons for combining references; under 35 U.S.C. 103, that does not constitute a bar.

Furthermore, in the case of Panduit Corporation v. Burndy Corporation (180 U.S.P.Q. 498), the District court ruled that inquiry into patentability must be directed towards subject matter as a whole and not to elements of combination and their individual novelty; combination which results in a more facile, economical, or efficient unit, or which provides results unachieved by prior art structures, cannot be anticipated piecemeal by showing that elements are individually old.

In the case of In re Bisley (94 U.S.P.Q. 80, 86), the Court ruled that patentability is gauged not only by the extent or simplicity of physical changes, but also by the perception of the necessity or desirability of making such changes to produce a new result. When viewed after disclosure, the changes may seem simple and such as should have been obvious to those in the field. However, this does not necessarily negate invention or

patentability. The conception of a new and useful improvement must be considered along with the actual means of achieving it in determining the presence or absence of invention. The discovery of a problem calling for an improvement is often a very essential element in an invention correcting such a problem. Though the problem, once realized, may be solved by use of old and known elements, this does not necessarily negate patentability.

In the case of *ex parte Chicago Rawhide Manufacturing Company* (226 U.S.P.Q. 438), the Patent Office Board of Appeals ruled that the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal, is not by itself, sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device. The Examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the reference device to render the here-claimed device unpatentable.

In the case of *The Standard Oil Company vs. American Cyanamid Company* (227 U.S.P.Q. 293), the court decided that the issue of obviousness is determined entirely with reference to a hypothetical person having ordinary skill in the art. It is only that hypothetical person who is presumed to be aware of all the pertinent prior art. The actual inventor's skill is irrelevant to the inquiry, and this is for a very important reason. The statutory emphasis is on a person of ordinary skill. Inventor's, as a class, according to the concepts underlying the constitution and the statutes that have created the patent system, possess something that sets them apart from the workers of ordinary skill, and one should not go about determining obviousness under 35 U.S.C. 103 by inquiring into what patentees (i.e., inventors) would have known or would

likely have done, faced with the revelation of references. A person of ordinary skill in the art is also presumed to be one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate, whether by patient, and often expensive systematic research or by extraordinary insight; it makes no difference which.

Finally, in the case of Meng and Driessen (181 U.S.P.Q. 94), the Court ruled that progress in crowded arts, usually made in small increments, is as important as it is in arts at the pioneer stage; constitution envisages and seeks progress in useful "arts," not just in those more esoteric or scientific.

Applicant has carefully considered the remaining references which were cited by the Examiner for being of interest but not applied in the case. After detailed analysis of these additional references, applicant has concluded that they are entirely unrelated to applicant's invention, and they do not anticipate the novel features of applicant's arrangement.

In view thereof, it is respectfully requested that the claims in the application be allowed and the case be passed to issue.

Respectfully submitted,

This amendment is being transmitted by fax on July 23, 2007.

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